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BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Application Number: 10/740,016
Filing Date: December 18, 2003
Appellant(s): VAN WULFFTEN PALTHE, PAUL J.G.

Fred Pruner, Jr.
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 9/6/07 appealing from the Office action mailed 2/16/07.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

5,329,998	KING et al.	07-1994
6,675,893	LUND	01-2004

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1, 2, and 4 are rejected under 35 U.S.C. 102(b) as being anticipated by King et al. (USP 5,329,998).

With respect to claim 1, King et al. discloses a one-trip system for use in a subterranean well comprising: a unit adapted to be run downhole into the well in a single trip (see column 2 lines 40-44), the unit comprising: a tubing hanger (76) adapted to be mounted to one of the well and a well casing near the earth's surface; a production tubing (40) sealingly attached to the tubing hanger (76) and adapted to receive a continuous medium riglessly deployed from the earth's surface (wherein the production tubing is capable of receiving continuous medium riglessly deployed from the surface); a perforating gun assembly (58) coupled to the production tubing (40); and a screen assembly (24) adapted to be engaged by the continuous medium to cause the release and movement of the screen assembly relative to the production tubing (wherein the adapted limitation

is functional and the assembly of King et al. is capable of being moved relative to the production tubing).

With respect to claim 2, King et al. discloses a packer (26) attached to a lower end of the production tubing (see figure 3C).

With respect to claim 4, King et al. discloses a surface-controlled subsurface valve (70) located in-line with the production tubing

Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over King et al. in view of Strattan et al. (USP 5,211,243).

King et al. does not disclose a valve located near the earth's surface and mounted about the tubing hanger to control flow of well fluids. Strattan et al. teaches the use of an annular safety valve (100) that can be run into the well in one trip along with other equipment, and suggests that a surface mounted valve is useful in order to prevent blow out in the event of an uncontrollable situation. Therefore, it would have been obvious to one skilled in the art at the time of the invention to modify the completion system of King et al. to include the safety valve of Strattan et al. in order to prevent blow out and increase the level of safety during well operations.

Claims 5 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over King. et al. in view of Ringgenburg et al. (USP 5,875,852).

King et al. does not teach an artificial lift device to assist in the production of well fluids; the artificial lift device being an electric submersible pump. Ringgenburg et al. teaches the use of an electric submersible pump in a well completion system, and suggests that a pump is needed to draw fluid form the

formation. See figure 2 column 9 lines 52-54. Therefore, it would have been obvious to one skilled in the art at the time of the invention to modify the completion apparatus of King et al. to include the electric submersible pump of Ringgenburg et al. in order to draw fluid form the formation when well pressure is low.

Claims 7 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over King et al. in view of Achee et al. (USP 6,216,785).

With respect to claim 7, King et al. does not disclose an upper sliding sleeve valve mounted in-line with the production tubing above the packer. Achee et al. discloses an upper sliding sleeve valve mounted above a packer (see column 6 lines 40-67) for flow control. It would have been obvious to one having ordinary skill in the art at the time of the invention to modify King et al. by including a sliding sleeve valve above a packer as taught by Achee, Jr. et al. in order to control flow in the assembly.

With respect to claim 8, King et al. does not disclose an extension having an intermediate sliding sleeve valve mounted below the packer (see column 2 lines 27-28). Achee, Jr. et al. discloses a sliding sleeve valve mounted below the packer (see column 2 lines 27-28) for flow control. It would have been obvious to one having ordinary skill in the art at the time of the invention to modify King et al. by including a sliding sleeve valve below a packer as taught by Achee, Jr. et al. in order to control flow in the assembly.

Claims 9-15 and 17-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over King et al. in view of Gano et al. (USP 6,382,323).

With regard to claims 9-15, 17, and 18, King et al. discloses the apparatus as applied to the claims above having a perforating assembly that includes a perforating gun (66), a firing head (see column 7 lines 7-11), a safety spacer (see figure 2C), a sand exclusion device with a sand screen (54), and an inner string (48) releasably mounted within the interior of the lower completion assembly, but does not teach a selective nipple; a shroud attached to the selective nipple; a no-go nipple mounted to the shroud; the perforating assembly mounted below the no-go nipple; a lock to keep the inner string secured to the selective nipple; a lower sliding sleeve valve; and a configuration in which the inner string can be moved from a first configuration of being mounted to the selective nipple to a second configuration in which it is mounted to the no-go nipple. Gano et al. discloses a releasable no-go tool having selective nipple (42), a shroud attached to the selective nipple, a no-go nipple (40) mounted to the shroud (44), a lock (48) to keep the inner string (20) secured to the nipple; and a perforating assembly (24) mounted below the no-go nipple; a lower sliding sleeve valve (54), in which the perforating assembly could be moved from the selective nipple to the no-go structure. Gano et al. suggest that a releasable no-go tool is useful in order to accurately position an item of equipment used in wellbore operations.

Therefore, it would have been obvious to one skilled in the art at the time of the

invention to modify the completion assembly King et al. to include the releasable no-go tool of Gano et al. in order to maintain the proper orientation of the tool during perforating and fracturing operations.

Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over King et al. in view of Gano et al. (USP 6,382,323) in further view of Donnelly et al. (USP 5,901,789).

King et al. in view of Gano et al. does not teach the use of a sand exclusion device with an expandable element. Donnelly et al. discloses such a device and suggests that an expandable element is useful to ensure a continuous mechanical contact between the screen and formation where there are inconsistencies in wellbore geometry. Therefore, it would have been obvious to one skilled in the art at the time of the invention to modify the apparatus of the combined references of King et al. and Gano et al. to incorporate the expandable sand exclusion element of Donnelly et al. in order to further prevent the migration of solid particles into a hydrocarbon wellbore.

Claims 9-15 and 17-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over King et al. in view of Shy (USP 6,199,632).

With regard to claims 9-15, 17 and 18, King et al. discloses the apparatus as applied to the claims above with the lower completion assembly having a perforating assembly that includes a perforating gun (66), a firing head (see column 7 lines 7-11), a safety spacer (see figure 2C), a sand exclusion device with a sand screen (54), and an inner string (48) releasably mounted within the interior of the lower completion assembly, but fails to teach a selective nipple attachedto a lower end of the upper completion assembly; a shroud attached to the selective nipple; a no-go nipple mounted to the shroud; the perforating assembly mounted below the no-go nipple; a lock to keep the inner string

secured to the selective nipple; a lower sliding sleeve valve; and a configuration in which the inner string can be moved from a first configuration of being mounted to the selective nipple to a second configuration in which it is mounted to the no-go nipple. Shy discloses a perforating apparatus having a selective nipple (38), a shroud attached to the selective nipple, a no-go nipple (74) mounted to the shroud; a lock (50) to keep the inner string (48) secured to the nipple; a perforating assembly mounted above the no-go nipple; a lower sliding sleeve valve (60); and a configuration in which the inner string can be moved form being mounted at the nipple to being mounted at the no-go nipple. Shy does not show the perforating assembly mounted below the no-go nipple. It is an obvious design choice to reverse the configurations to modify the design. (Shy column 12 lines 45-48). Shy suggests that the configuration of components is useful in single trip perforation and fracturing operations to ensure proper alignment of the tool both in an axial and circumferential orientation. Therefore, it would have been obvious to one skilled in the art at the time of the invention to modify the completion system of King et al. to include the locating nipples of Shy in order to maintain the proper orientation of the tool during perforating and fracturing operations. Absent a showing of criticality in the location of the perforating gun in relation to the no-go nipple, the Shy reference meets the limitations of the claims.

Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over King et al. in view of Shy in further view of Donnelly et al.

The combined reference of King et al. and Shy teaches the apparatus as applied to the claims above, but fails to teach the use of an sand exclusion device with an expandable element. Donnelly et al. discloses such a device and suggest that an expandable element is useful to ensure a continuous mechanical contact between the screen and formation where there are inconsistencies in wellbore geometry. Therefore, it would have been obvious to one skilled in the art at the time of the invention to modify the apparatus of the combined references of King et al. and Shy to incorporate the expandable sand exclusion element of Donnelly et al. in order to further prevent the migration of solid particles into a hydrocarbon wellbore.

Claims 30-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lund (USP 6,675,893).

With respect to claim 29, Lund discloses a method to complete a subterranean well in one trip comprising: providing a one-trip completion system (see abstract) including at least a perforating gun and a production tubing (see column 2 lines 7-12, wherein Lund teaches that it is well known to convey a perforating gun and a production tubing into the well together. It would have been obvious to one having ordinary skill in the art at the time of the invention to modify Lund by conveying the perforating gun and the production tubing in one trip in order to save time and money.); running the one-trip completion system into the well in a single trip using a rig (see column 14 lines 8-16); removing the rig (see column 14 lines 8-16); after the removal of the rig, running a continuous medium downhole into the one-trip completion system (see column 14 lines 1-

16); and actuating and operating the one-trip completion system using the continuous medium (see column 5 lines 1-30).

Lund teaches activating and operating the one trip completion system using a wireline. See column 5 lines 1-30. It would have been considered obvious to one of ordinary skill in the art, at the time the invention was made, to have used coiled tubing, since the examiner takes Official Notice of the equivalence of a wireline and coiled tubing for their use in the continuous medium art and the selection of any of these known equivalents to activate and operate a one-trip completion system would be within the level of ordinary skill in the art. Furthermore, wireline and coiled tubing are considered equivalents as indicated by original claim 30.

With respect to claim 31, Lund discloses that the actuating and operating includes performing a gravel pack operation (see column 14 lines 3-5).

With respect to claim 32, Lund discloses that the actuating and operating includes performing a fracturing operation (see column 14 lines 63-67).

With respect to claim 33, Lund discloses that the actuating and operating includes performing a perforating operation (see column 14 lines 1-2).

With respect to claim 34, Lund discloses that the actuating and operating includes moving a sand exclusion device to a position adjacent perforations in a well casing (see column 4 line 54 to column 5 line 30, wherein filter 32 is a screen which comprises valve 55, which is moved by a wireline).

(10) Response to Argument

I. The rejected under 35 USC 102(b): King et al.

Claims 1, 2, and 4 are rejected under 35 U.S.C. 102(b) as being anticipated by King et al. Appellant argues that King et al. does not discuss or suggest a continuous medium that is run inside the inner service flow conductor 40.

However, it is noted that the claim does not positively recite a continuous medium. It has been held that the recitation that an element is "adapted to" perform or is "capable of" performing a function is not a positive limitation but only requires the ability to so perform. Thus, the production tubing just needs to be capable of receiving a continuous medium. In the instant case, the bore in production tubing 40 is capable of receiving a continuous medium, and thus the claims are not allowable over the prior art.

The Applicant also argues that King et al. fails to teach or even suggest engaging any of the sand screens 24 via a continuous medium that is deployed inside the flow conductor service string 38.

First it is noted that the applicant does not claim the step of deploying a continuous medium inside the flow conductor service string. The Applicant claims a screen adapted to be engaged by a continuous medium. The "adapted to" language limits the screen assembly to a structure *capable of* being engaged by a continuous medium to cause the release and movement of the screen assembly. In this case, the screen assembly in King et al. is capable of being engaged by a continuous medium. Furthermore, the screen assembly in King et

al. is capable of being released and moved by continuous medium, if the continuous medium had a cutter attached to it.

II. The 35 USC 103(a) rejection of claims 28-34: Lund

Appellant argues that Lund fails to teach or suggest running a one-trip completion system into a well in a single trip, where the one-trip completion system includes at least a perforating gun and a production tubing. The Appellant argues that Lund teaches running a production tubing string into the well after a perforating and packing assembly and therefore, a prima facie case of obviousness has not been set forth. However, as noted above, Lund does disclose that one trip completion systems with production tubing and perforating guns are known in the art and as noted above it would have been obvious to one having ordinary skill in the art to modify Lund by inserting the perforating gun and production tubing at the same time in order to save time and money. Therefore, the claims are not allowable over the prior art.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

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